

Appl. No. : 09/682,853
Filed : October 24, 2001

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

Applicant apologizes for the error noted by the Patent Office in the Notice of Non-Compliant Amendment. Applicant has correctly noted claim 11 as "cancelled". For the Patent Office's convenience, the entire text of the remarks are re-submitted herein.

Initially, the rejections to claims 1 and 17 based on 35 U.S.C. 112 have been obviated herein by amendment. After changing the portion in line 5 of claim 1, the portion in line 6 now reads "said request to query a publicly accessible source of information" which enjoys clear antecedent basis.

Claims 1-3, 5-7, 16-21 and 23 stand rejected under 35 U.S.C. 103 as allegedly being unpatentable over Chen in view of Steele. This contention remains respectfully traversed.

As explained in the previous official action:

- 1) Chen teaches away from requesting additional information, and therefore it would not be obvious to combine this with a reference which requests additional information, and
- 2) even if the combination were made, the hypothetical combination still would not teach what is now claimed. This is explained again below.

In response to arguments, the Patent Office states: "the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art", citing multiple cases. However, this

Appl. No. : 09/682,853
Filed : October 24, 2001

misses the point that a reference that teaches away DOES NOT SUGGEST contradicting what it teaches away from.

It is well established that it is not proper to combine references when the proposed modification would render the prior art unsatisfactory for its intended purpose; see MPEP 2143.01, citing In re Gordon, 221 USPQ 1125 (Fed Cir 1984). As established in the previous rejection, and reiterated herein, the proposed modification would in fact render the prior art unsatisfactory for its intended purpose. Even if the Examiner is correct that Steele shows suggestion or motivation, no amount of suggestion is proper if it renders the other prior art unsatisfactory for its intended purpose, or changes the principal of operation of the prior art. See generally MPEP 2143.01.

In the response to arguments reference to applicants argument on page 10 last paragraph, it is noted that applicant never intended to say that Steele does not request any kind of more information. In fact, and as previously explained, Steele does request more information in the context of an advertisement. However, the claim and the arguments on page 10, specifically recite that interactive device identifies "... more information about a specific query to be made to said publicly accessible source of information". The response to arguments does not identify any such publicly available source of information. It may ask the user for more information, but does not teach a publicly available source. With all due respect, this response to argument clearly ignores the specific claim language.

Finally, the response to arguments refers to page 12 and states that Steele teaches nothing about confirming actions and refers to paragraph 117 on page 7. Admittedly, this paragraph uses the term "confirmation", but does not do it in the context

Appl. No. : 09/682,853
Filed : October 24, 2001

of the claimed system. The method is described as providing a confirmation that something has been delivered. Claim 23 defines sending a request for confirmation of contents of the action. The claims define an entirely different thing than the subject matter of claim 23.

Therefore, and for all of these reasons, it is respectfully suggested that the rejection is and remains incorrect. More detailed reasons follow:

I. Chen Teaches Away From Requesting Additional Information, And Therefore One Having Ordinary Skill In The Art Would Not Combine Chen With Any Kind of Reference Which Teaches Requesting Additional Information.

Claim 1 specifies sending a request for information, and then sending back a request that requests the interactive device to identify more information about the specific query to be made. However, it is respectfully suggested that Chen teaches away from requesting identification of more information in this way, and therefore that it would not be obvious to combine Chen with any reference that suggests obtaining additional information.

It is well established in the case law and in MPEP 2143.01, that prior art can only be combined when the prior art itself suggests the desirability of the claimed combination. Here, in fact, the prior art teaches AWAY from the desirability of such a combination.

Chen teaches using a mobile device to issue requests, one of which is for example the latest stock price. See for example Chen at paragraph 11. As part of the request, the engine "transforms command aliases" of the request as it is received. That

Appl. No. : 09/682,853
Filed : October 24, 2001

is, the engine tries to make sense of the command as is, rather than requesting further information about the command. This is entirely consistent with all of the teaching throughout Chen. For example, consider the command syntax disclosed in paragraph 55. Paragraph 57 describes that the engine components form aliases and authenticates the user. Again here, the engine components attempts to recognize the command as is; the antithesis of asking for additional information about the command.

In all of Chen's embodiments, when the system needs more information than it has, it finds the additional information from the user profile, not by asking for additional information. See for example paragraph 76 which explains that when Chen requires additional information, it obtains it from the profile. In paragraph 101, when the system needs to know who to send the information to, it gets it from the profile. All in all, it should be seen that Chen teaches that when not enough information is obtained about the request that is received, then the additional information should be figured out based on internal logic and the user profile.

Any attempt to modify Chen to operate in a different way would go against the teaching in Chen about how to interpret incomplete requests. Accordingly, one having ordinary skill in the art would not modify Chen to request additional information. In fact, doing so would go against the teaching in Chen, making this an improper combination under MPEP 2143.

Therefore, one having ordinary skill in the art would not combine Chen with Steele or with any other reference that showed obtaining additional information.

II. Even If The Hypothetical Combination Of Chen In View Of Steele Were Made, It Would Still Not Teach Or Suggest The Claimed Subject Matter.

Appl. No. : 09/682,853
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Steele teaches a multimedia system which, as part of the system, includes advertisements. The user can request, and receive, additional information about the product being advertised. For example, the user can request information using an INFO button such as 172 (paragraph 56) which causes the advertising database to provide information about the advertisement that is being run (see paragraph 63). The user can also request buying information.

However, this in combination with Chen, is very different than what is currently claimed. Claim 1 defines a request for information being sent from an interactive device to a first recipient, and that the first recipient requests the interactive device to identify more information about the query. In Steele, a user receives advertisements, and can request more information about the advertisement. However, Steele's advertisement is not a "query" as claimed. Moreover, Steele's advertisement is not a request for information sent from an interactive device to a first recipient. Rather, Steele's advertisement is sent over an Internet channel to all users. The recipient can send a request for more information about the advertised product, but the recipient does not send a request for "said interactive device to identify more information about a specific query to be made to said publicly accessible source of information", emphasis added. Quite simply, while Steele requests information, it is not "information about a specific query to be made", but is rather information about an advertisement. An advertisement is not a specific query to be made to a publicly of accessible source of information. A query to a source of information requests that the source of information return some answer. In contrast, an advertisement sent to a number of users does not request an answer to a specific question.

Appl. No. : 09/682,853
Filed : October 24, 2001

Therefore, Steele does not suggest requesting more information about a query sent from an interactive device with the purpose of querying a publicly available source of information. Steele ONLY teaches requesting more information about an advertisement.

Therefore, a hypothetical combination of Chen with Steele would produce a Chen type system with a Steele type system that may allow requesting additional information about advertised items. Therefore, claim 1 should be allowable along with claims 2-8 which depend therefrom. Each of these claims should be allowable on their own merits.

Claims 11-16 have been canceled in order to obviate the rejections thereto.

Claim 17 specifies receiving a request for information from a publicly available source of information, and sending a request to the client for more detail about that request. As described above, the hypothetical combination of Chen in view of Steele (1) would one not be operatively made by one having ordinary skill in the art, and (2) even if made would simply teach a Chen type system with Steele system of requesting additional information about an advertisement. Nothing in the hypothetical combination teaches or suggests how an interactive device could query a publicly available source of information by obtaining more information about the query itself. Therefore, claim 17 should be allowable along with the claims which depend therefrom.

Claim 21 specifies sending a text message from an e-mail pager to a specified address and includes text content including an action that the user wants to carry out, second sending a text message back, and after sending that, carrying out an operation. As described above, Chen in view of Steele would not teach or suggest this feature, since it would just teach a Chen type system with a Steele advertisement request.

Appl. No. : **09/682,853**
Filed : **October 24, 2001**

Therefore, claim 21 is not obvious based on the references, and should be allowable along with the claims which depend therefrom.

Claim 23 should be specifically allowable as it specifies that the second sending is a request for confirmation of contents. This may be useful in a situation where the command may be ambiguous, and in that case, the second sending may be a request for confirmation. The rejection attempts to read this as being a "request for information of contents of said action" as disclosed in Steele paragraph 131. However, this cited section simply teaches sending information to the vendor that indicates there is a user that meets certain requirements; allowing the vendor to request additional detail. It is certainly not a request for confirmation of contents of an action, as claimed. In fact, Steele teaches absolutely NOTHING about any messages CONFIRMING any actions, not even in the specific advertising context. Therefore, Claim 23 should be allowable.

Claim 8-10 was rejected over Chen in view of Rajan. Claim 8 defines that the source of information indicates a user's bank balance, which is even further patentably distinct from the references.

Claim 8 also includes the limitations of claim 5 in which the sending requires that the user provide some personal information to verify their identity. This combination is in no way taught or suggested by the hypothetical combination of prior art. Rajan teaches nothing about this.

Claim 9 specifies that the reformatting is done according to a prestored template. Rajan does teach that information can be reformatted between templates, but teaches nothing about the subject matter of claim 9 which specifies reformatting for an interactive device according to a prestored template. Therefore, claim 9 should be allowable along with claim 10 which depends therefrom.

Appl. No. : 09/682,853
Filed : October 24, 2001

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the above amendments and remarks, therefore, all of the claims should be in condition for allowance. A formal notice to that effect is respectfully solicited.

Please charge any fees due in connection with this response to Deposit Account No. 50-1387.

Respectfully submitted,

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